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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,215	03/04/2004	Jose E. Perez	100629.53016C1	4196
23911	7590	11/03/2005		
CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			EXAMINER FIDEI, DAVID	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/792,215	Applicant(s) PEREZ ET AL. <span style="float: right;">C</span>	
	Examiner David T. Fidei	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 is/are allowed.
- 6) ☒ Claim(s) 24-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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***Drawings***

1. The drawings were received on August 29, 2005. These drawings are not objected to by the Examiner.

***Double Patenting***

A timely filed terminal disclaimer was received August 29, 2005 in compliance with 37 CFR 1.321(c). Therefor, the previous rejection made under this basis have not been maintained.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 24- 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Intini (Patent no. 5,575,399). A storage container is disclosed comprising a lid 14 and a base 12. The relative dimension of the base compared to user's hand to receive a disc. Some mini discs appear to be about half the size of the base. As shown in figures 2 and 6 a front portion of the lid wall comprises a recess 46. The storage container further comprises a tab 40 including a first portion attached to the base and a second portion extending within the recess when the storage container is closed, see figure 6a.

As to claim 25, the force required to disengage the latch to open the storage container is greater that a force required to engage the latch to close the storage container based upon the disclosure of the present specification. The taper of the tab 40 glides over an interlocking surface 48 akin to the present disclosure where it is manifestly evident force required to disengage the latch to open the storage container is greater that a force required to engage the latch to close the storage container

As to claims 26 and 27, a hinge panel 36 is shown in figures 8 and 9 comprising a first end pivotally coupled to a second portion of the lid and second end pivotally coupled to a second portion of the base panel.

As to claim 28, a first closing member 12 comprising a first panel 24 and peripheral wall defined by members 22, 24. The first closing member comprising a detent member 58. A second closing member 14 has a second panel 26 and peripheral wall including an aperture 64 having a catch member 66 to receive and lock with the detent member 58, see figure 5. A hinge panel 36 comprises a first end pivotally coupled to a second portion of the lid and second end pivotally coupled to a second portion of the base panel.

The difference between the amended claimed subject and Intini resides in a base configured to securely support an optical disc (claims 24-26) and wherein said second closing member is adapted to securely support an optical disc (claims 27 & 28). However, the difference between the claimed subject matter and Intini in this regard resides in the height, width or depth of the container. As noted previously some "mini" discs are not the size of conventional disks. In any event, the specific dimensions of the container's height, width or depth are normally considered to be an obvious matter of design choice to construct the, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Also, it has been held that where the only difference between the prior art device and the claimed device was a recitation of relative dimensions, the claimed device was not patentably distinct from the prior art device, Gardner v. TED Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984); cert. Denied, 469 U.S. 830, 2325 USPQ 232 (1984), see M.P.E.P. 2144.04 (IV). To construct the container of a dimension adapted to securely support an optical disc would have been obvious to one skilled in the art as matter of routine skill.

#### ***Allowable Subject Matter***

4. Claims 1-23 are allowed.

*Response to Arguments*

5. Applicant's arguments filed August 29, 2005 have been fully considered but they are not persuasive. While the Examiner agrees with applicant that it does not appear the patent Intini has the physical characteristics for holding an optical disc, it is not agreed a motivation is required that suggests modifying Intini to hold an optical disc. The optical disc is not claimed in combination with the container. Rather, the container is broadly claimed with a latching structure generally known in the container art as demonstrated by Intini. Furthermore, it only required that there be some motivation for changing the physical characteristics of Intini in order to meet the invention in as claimed. All that appears to be required of Intini in order to arrive at a base configured to securely support an optical disc, or a second closing member is adapted to securely support an optical disc resides in the dimensions of the container. Since it is apparent optical discs can be stored in a vertical position and the dimensions of optical discs can have a wide degree of variance, the differences between Intini and the claimed invention are merely dimensional parameters widely accepted to be parameters within the level of ordinary skill.

Accordingly, the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains

*Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner concerning the merits of the claims should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David T. Fidei  
Primary Examiner  
Art Unit 3728

dtf  
August 8, 2005